

REMARKS

Remaining Claims

Through this Amendment, claims 1-2, 5, 8, and 9 have been amended and claims 15-18 have been added. Twelve (12) claims (Claims 1 – 3, 5 – 9, and 15-18) remain pending in this application after this Amendment.

Rejections under 35 U.S.C. §112, second paragraph

Claims 1-3 and 5-9 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully submit that this rejection has been overcome by the amendment of claims, 1, 5, 8, and 9. Claim 1 has been amended to specify the reaction between the first reactive group of the copolymerization product and the second group of the organic compound. Claim 8 has been amended to be dependent upon claim 1. Claim 5 has been amended to correct the typo pointed out by the examiner. Claim 9 has been amended to more clearly point out and distinctly claim the invention. As such, Applicants respectfully request withdrawal of this rejection. Applicants also wish to express their appreciation to the Examiner for his kind suggestion in this regard.

Rejections under 35 U.S.C. §112, first paragraph

Claim 2 has been amended to overcome the §112, first paragraph rejection. Applicants respectfully request withdrawal of this rejection.

Rejections under 35 U.S.C. §102/§103

Claims 1-3 and 5-9 were rejected under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Valint, Jr. et. (U.S. 5,981,669) or Valint, Jr. et al. (U.S. 5,981,675). For the following reasons, the Examiner's rejection over claims 1-3 and 5-9 is respectfully traversed.

Applicants' invention is not anticipated by nor obvious in light of either of the two cited references (the '669 patent and the '675 patent), because none of the cited references discloses or suggests all of the claim limitations. To anticipate a claim, a single source must contain all of the elements of the claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *Atlas Power Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984); *In re Marshall*, 578 F.2d 301, 304, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978). In addition, the single source must disclose all of the claimed elements "arranged as in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989); *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983). As stated in the MPEP at 706.02(j), to

establish a prima facie case of obviousness the "prior art reference (or references combined) must teach or suggest all the claim limitations."

The '669 patent discloses a hydroxyl or amino terminated silicone-containing prepolymer which is a free-radical polymerization product (Example 1) of a mixture including various ethylenically unsaturated monomers and a chain transfer agent (Abstract, col. 2, lines 8-67 and cols. 3-5). However, the '669 patent does not disclose nor suggest anything about a silicone-containing prepolymer having ethylenically unsaturated groups, and anything about a **crosslinker** with two or more ethylenically unsaturated groups being one of the components in the copolymerization mixture.

The '675 patent discloses a silicone containing macromer which is prepared by, first, copolymerizing by free radical polymerization a mixture of the ethylenically unsaturated silicon-containing monomer (a), the ethylenically unsaturated monomer containing an active hydrogen atom (b) and the ethylenically unsaturated monomer (c) (if present), in the presence of the chain transfer agent (d), to obtain a copolymer, and subsequently, reacting the copolymer with a suitable ethylenically unsaturated radical to form the macromonomer having the ethylenically unsaturated radical. (col. 3, lines 11-22, Examples 1-9). But, the '675 patent does not disclose nor suggest anything about a **crosslinker** with two or more ethylenically unsaturated groups being one of the components in the copolymerization mixture.

In contrast to both '669 and '675 patents, a silicone-containing prepolymer of the invention comprises ethylenically unsaturated groups and is prepared by reacting an organic compound having an ethylenically unsaturated group and an reactive group with a copolymer which is obtained by copolymerization of a mixture including at least one hydrophilic monomer and at least one crosslinker comprising two or more second ethylenically unsaturated groups in the presence of a chain transfer agent comprising a chain transfer group and a reactive group.

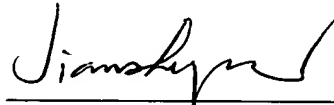
Therefore, because none of the cited references discloses or suggest all of the limitations of the present invention, Applicants' invention is not anticipated by nor obvious in light of either of the two cited references (the '669 patent and the '675 patent). Applicants respectfully request withdrawal of the rejections under 35 U.S.C. 102(e) and under 35 U.S.C. 103(a).

CONCLUSION

In view of the foregoing and in conclusion, Applicants submit that the rejections set-forth in the Office Action have been overcome, and that all pending claims are now in condition for allowance.

Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned. Please address all correspondence to Robert Gorman, CIBA Vision, Patent Department, 11460 Johns Creek Parkway, Duluth, GA 30097. The Commissioner is hereby authorized to charge any other fees which may be required under 37 C.F.R. §§1.16 and 1.17, or credit any overpayment, to Deposit Account No. 50-2965.

Respectfully submitted,



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